

**REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1-16 remain pending in this application. Claims 17-27 have been cancelled. Claims 1--- have been amended.

Claims 1-16 have been rejected under 35 USC 112, second paragraph. Applicant has amended the claims and believes that the rejection is now moot and respectfully requests withdraw of the rejection.

Claims 1-16 have been rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Martin 5458282 in view of Newman et al 3658567. Reconsideration and withdraw of the rejection is earnestly solicited.

The Examiner suggests that adhesive bonds are equivalents to frangible bonds, applicant respectfully disagrees. Applicant would suggest that Newman et al clearly teach away from what has been suggested in the Official Action and that frangible coatings are opposites to that of adhesive coatings. Adhesives are commonly used to adhere or stick items together which is what is required in Martin, whereas frangible coatings are intended to break apart which is what is intended by Newman et al to have the coating break off from the sheet to which it is applied. Staples and paper clips are each used to hold sheets of paper together yet one with skill in the art would readily recognize that they are not equivalent structures and are each used to accomplish different results. The same is the case with the present invention.

Newman et al relate to the manufacture of “transfer sheets and ribbons of the so-called carbon paper type” column 1, lines 3-4 and does not remedy the deficiencies of Martin. Transfer sheets or carbon paper as disclosed in Newman et al, transfer an image created by a waxy layer, when pressure is applied to a top layer, to an underlying layer. The wax of the transfer layer transfers to the sheet upon which an image is to be replicated. Newman et al do nothing to show equivalents of frangible coatings to adhesive coatings. The frangibility of the coating in Newman et al simply infers that the coating breaks away and attaches to the underlying image receptive sheet on receiving impact pressure.

In addition, certain types of adhesives may be used to stick repeatedly to multiple surfaces. Frangible coatings could not achieve such a result. For example, consider a pad of repositionable, Post-It® type notes which includes a series of sheets that are held one to another through the use of a repositionable adhesive. One may remove a sheet from the pad and adhere the sheet to a surface and then may re-adhere the sheet back to the pad through the adhesive bond. Similarly, removable adhesives, while having a higher level of tack will generally allow one to remove the substrate from one surface and re-adhere the substrate to another surface through use of the adhesive bond. Likewise, permanent adhesives when disposed on a release liner may be easily removed and adhered to a surface. If the permanent adhesive has already been adhered to a surface, the item typically cannot be removed without ripping or tearing, if at all. Moreover, once the bond using a permanent type of adhesive has been formed, it generally cannot be broken absent destruction of the substrate. None of the foregoing examples are similar to the functionality of the frangible bond used in the present invention which when broken does not destroy the substrate nor can the coating be used again.

Frangible bonds are distinct from adhesive bonds. The frangible coating that is used in the present invention temporarily holds two surfaces of material together. Once the bond is broken, neither of the substrates which made up part of the construction can

be adhered to another surface or even back to one another. Thus, bonds created by adhesives and bonds created by frangible coatings are not known equivalents and may not be substituted for one another as each has its own unique characteristics.

Frangible bonds are used when one does not want either portion of a laminate to be able to be re-adhered or become attached adhesively to another surface. Once the bond is broken, each portion of a laminate is then substantially free of residue such that each portion of the laminate may be used without fear of contamination, such as may be the situation with adhesively bonded materials.

One could not utilize the coating in Newman et al in the present combination as the coating in Newman et al is not intended to bond layers one to another but is instead a coating applied to a sheet to form carbon paper. The term "pressure sensitive" which is used to refer to a layer that is represented by numeral 18 in Figure 2, refers not to an adhesive, but rather to a layer that is sensitive to the application of pressure. No impact pressure is required to utilize the coating incorporated in the present invention. Moreover, if one were to break the entire bond of the waxy layer, assuming a bond is created by the Newman et al formula, then the product would no longer function as carbon paper as the entire layer would fracture rendering it inoperable as carbon paper and thus destroying the purpose of Newman et al.

Even if one were to use the frangible coating as suggested by the Examiner with Martin, as the Martin construction is intended to be handled through the mail, the processing equipment would likely cause the surface to delaminate. Thus one would receive a piece of paper as the magnet would have broken off during handling or alternatively if the magnet became magnetically attracted to equipment during processing the magnet would delaminate from the substrate due to the frangible bond.

In order for there to be inherency there must be certainly not a mere probability. In this regard see *In re Robertson*, 49 USPQ2d 1949, 1950, 1951 (Fed. Cir. 1999) wherein the Court held:

“If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is ‘inherent’ in its disclosure. To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’ *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). ‘Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ *Id.* at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich* 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In finding anticipation by inherency, the Board ignored the foregoing critical principals. The Board made no attempt to show that the fastening mechanisms of Wilson that were used to attach the diaper to the wearer also ‘necessarily’ disclosed the third separate fastening mechanism of claim 76 used to close the diaper for disposal, or that an artisan of ordinary skill would so recognize...

Indeed, the Board’s analysis rests upon the very kind of probability or possibility – the odd use of fasteners with other than their mates – that this court has pointed out is insufficient to establish inherency.”

The Examiner has also overlooked and failed to consider other limitations that are not taught or suggested by the references and each of which must be given patentable weight. The Office Action is silent as to these additional features. Neither Martin or Newman et al or the combination teach or suggest the use of a plurality of die cuts to create removable magnetic pieces. There is also no teaching or suggestion that when the removable portions are taken away from the laminate that the portions are substantially free of residue. There is also no teaching or suggestion that each of the removable magnetic pieces has at least one image as required by claim 10.

Martin teaches only a solid magnet and does not disclose the presence of any die cuts in the magnetic material that could be used to create removable magnetic portions, let alone magnets having individual images.

It is believed by applicant that there is no substantially identical structure provided by the combination as a number of the limitations provided in the claims are simply not found in the references individually or the suggested teachings of either of the references or the resulting alleged combination and the use of adhesive is not simply interchangeable with the use of frangible coatings. In order for there to be an anticipation of the invention or a *prima facie* case for obviousness, each of the limitations must be found in the references or in their teachings. Here they are simply not.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited. The Examiner is encouraged to contact the undersigned in the event any small matters remaining outstanding so as to eliminate the necessity of another action and response.

Respectfully submitted,



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